

Remarks

The examiner has rejected claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,752 to Rivette et al. ("the '752 patent") in view of U.S. Patent No. 6,157,947 to Watanabe et al. ("the '947 patent"). These rejections are respectfully traversed.

Applicant has amended claims 1, 3 and 8. Entry of the Amendment, and favorable consideration thereof is earnestly requested.

As amended all of the claims require among other elements, software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property, and software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document.

Applicant notes that the examiner has submitted that the '752 patent fails to disclose software executing on said Internet server for receiving a transfer request. However, the examiner has further submitted that the '947 patent discloses the above-listed elements. Applicant respectfully disagrees.

The present invention is directed toward a system for the transfer of property rights. A user may access the system in order to transfer the ownership and legal rights to a particular intellectual property from one entity to another. Software executing on a server aids the user in accomplishing a desired transfer of property rights. Therefore, as used in the present application, a transfer request is a request to transfer ownership or legal property rights from one entity to another entity. The system as claimed in the

present application analyzes a property transfer request by a user, selects the proper transfer form, and generates a property transfer document based upon information retrieved by the system.

In contrast with the present invention described above, applicant respectfully submits that the '947 patent is directed to a system that "is to provide a distribution technique ... for distributing intellectual property, in particular, semiconductor design property, so that users can easily re-use it." (Col. 1, lines 38-41) The '947 patent does not disclose a "transfer request" as utilized and claimed in the present application. Rather, the '947 patent is directed toward the physical transfer of proprietary information over the Internet to various requesters. (Col. 1, lines 45-53; Col. 7, lines 19-26 and 46-52) For instance, the '947 patent discloses that "in the distribution system, a data transferring process (transferring IP information) is started and carried out in accordance with a transferring request of the client" and "CORBA (Common Object Request Broker Architecture) is used for transferring data between servers in the intranets, and FTP (File Transfer Protocol) is used for transferring data between server in the Internet, by considering security and efficiency of the data transferring process." (Col. 7, lines 22-25 and 26-31) The '947 patent further discloses that "the transferring request server 20, the processing portion 21 issues a transferring request for IP information and receives the IP information through the communication portion 23; and the IP information received by the processing portion 21 is stored in the memory portion." (Col 7, lines 36-41) The '947 patent still further discloses that "the processing portion 31 acknowledges the transferring request for IP information, checks the right of the transferring request server (client) 20, and then, transfers the IP information ... to the transferring request server." (Col. 7, lines 46-52)

The system taught in the '947 patent then, is directed toward an information distribution system where a user can input a transfer request such that the system will physically deliver or transfer some proprietary information to the requester. This is radically different from the present invention in which a transfer request is a request to

transfer the ownership or legal rights to some property from one entity to another. Therefore, the '947 patent fails to teach, disclose or suggest "a transfer request indicative of a transfer of rights to the property" as required by all the claims of the present invention.

The '947 patent also fails to teach, disclose or suggest software executing on said Internet server for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document. Specific legal forms are required for property transfers. The system of the present invention will analyze the requested property transfer, and based upon various information, select the correct recordation form needed to accomplish the property transfer. This is not taught in the '947 patent. The examiner has submitted that this element is disclosed at Col. 8, lines 19-26 which state "retrieval data from the IP information, and step S26 retrieves a necessary piece of intellectual property according to the catalog retrieval data. Step S24 prepares an HTML (Hyper Text Markup Language) document from the IP information." Applicant respectfully submits that neither in this section, nor in any other section of the '947 patent is, "querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request", or "for combining the retrieved information record with the retrieved recordation form to generate a document" taught or disclosed as required by all the claims of the present invention. Rather than teach selection and retrieval of a specific recordation form to be merged with the retrieved information, the '947 patent merely teaches that the requested information is simply presented in HTML format with no mention of selection of a proper recordation form. In fact, nothing is taught or disclosed in the '947 patent relating to any kind of recordation form.

Therefore, because the '947 patent fails to teach, disclose or suggest software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property, and software executing on said Internet server for querying

said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document as required by all the claims of the present invention, it cannot alone or in any combination with the '752 patent render the claims obvious.

Applicant still further submits that there is no motivation to combine these two references as they deal with vastly different problems. The '752 patent, while failing to disclose software for receiving a transfer request, generally is directed toward a system for maintaining databases for patent and non-patent information, while the '947 patent is directed toward a system for the physical delivery of proprietary information (intellectual property, especially semiconductor design information) over the internet. If one were to combine these two patents, one would not arrive at the present claimed invention. For instance, one could arrive at a system that could relate patent information with non-patent information that could be transferred or delivered to a requester over the internet.

Neither the '752 patent nor the '947 patent teach, disclose or suggest the transfer of rights, ownership or legal title of property or the querying of a database of appropriate forms to facilitate the property transfer as required by all the claims of the present invention. Therefore, none of the present claims can be obvious in light of the suggested combination.

Page 10
Serial No. 09/725,394
August 20, 2003

It is respectfully submitted that claims 1-10, all of the claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,



Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155